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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

13DV-13928 (07783-0076)

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on March 22, 2006

Signature _____

Typed or printed
name _____Holly J. Lawrence

Application Number

09/900,684

Filed

July 6, 2001

First Named Inventor

NABB et al.

Art Unit

3625

Examiner

Nicholas D. ROSEN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒attorney or agent of record. 50,311

Registration number _____

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____


SignatureShawn K. Leppo

Typed or printed name

717-232-8000

Telephone number

March 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket No. 13DV13928 (07783-0076)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

Robert William NABB, et al.

Patent Application No.: 09/900,684

Filed: July 6, 2001

Group Art Unit: 3625

Examiner: Nicholas Rosen

Confirmation No.: 6738

Title: SYSTEM FOR ELECTRONICALLY SUBMITTING AND MONITORING COPY REPRODUCTION JOBS

MAILSTOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request for Review is filed in response to a Final Office Action dated December 22, 2005 in the above-captioned application (the "Application") in accordance with the procedures announced in the Official Gazette on July 12, 2005 as extended in the Official Gazette on February 7, 2006. A Notice of Appeal and the requisite fee is filed concurrently herewith. A Response to the Final Rejection is filed separately on this date to address a claim objection in which the Examiner required correction of a grammatical error; no other claim amendments were presented.

**CONCISE STATEMENT OF ISSUES TO ACCOMPANY THE
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Pending claims 1, 3, and 5-10, and 12-20 remain rejected under 35 U.S.C. §103(a) by Blumberg in view of Official Notice. Claim 11 remains rejected under 35 U.S.C. §103(a) by Blumberg in view of Official Notice and in further view of U.S. Patent 6,224,387 and the anonymous article "Internet Printing Solutions."

The Examiner has committed clear error by failing to establish a prima facie case of obviousness and by erroneously holding Applicants' arguments as improperly traversed.

As discussed in more detail at pages 10-11 of the Response filed by Applicants on October 17, 2005 (the 10/17/05 Response), the rejection by the Examiner all of the pending claims is clearly erroneous because the Examiner has failed to make out a prima facie case of obviousness, admitting that the cited reference fails to teach, disclose or suggest each and every limitation of Applicants' claimed invention. See, e.g., Final Office Action at pgs. 3-5, acknowledging no less than three elements of independent claim 1 not found in Blumberg, the cited reference. The Examiner also admits that the cited reference fails to teach limitations found in each of independent claims 12 and 18, as well as dependent claims 5, 6, 7, 8, 9, 10, 11, 14, 15, 16, 17, and 20. In the Final Office Action, the Examiner continues his attempt to overcome the lack of teachings by the cited reference by relying on Official Notice and simply stating that all of the untaught limitations were well-known.

Admitting that a cited reference fails to teach no less than three limitations in the first independent claims, much less admitting that claims depending therefrom containing even more limitations not found in the cited reference, and then attempting to overcome that mountain of untaught limitations by a mere assertion of "well known" could not possibly be the "judicious application" of Official Notice found in the introductory sentence of MPEP 2144.03.

As discussed in the 10/17/05 Response, the Examiner has improperly used Official Notice in an attempt to construct a non-existent prior art reference out of whole cloth that is now

said to teach or suggest all of the limitations of Applicants' claimed invention. Not only is this improper under the Patent Office's strict guidelines for use of Official Notice, but it also fails the axiomatic requirement that the claimed invention must be viewed taken as a whole in light of the prior art. "In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious" to one of ordinary skill in the art at the time the invention was made. MPEP 2142.

That is, even if the Examiner had a single, actual prior art reference that taught all that is now said to be officially noticed, without some suggestion to combine the teachings of that reference with Blumberg, the Examiner would be doing nothing more than selecting features from a laundry list of known components to re-construct Applicants' claimed invention. Hindsight rationalization in light of the disclosure of the specification being examined is not permitted. MPEP 2143 and 2143.01. It is well established that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." MPEP 2142.

Furthermore, MPEP 2143.01 (IV) states that the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness." Despite this clear prohibition, the Examiner has done exactly this in the instant case. In attempting to combine the Official Notice with Blumberg in making the rejections, the Examiner merely states that it would be advantageous to combine officially noticed facts with the teachings of Blumberg to arrive at Applicants' claimed invention. See, e.g. Final Action at page 5. This is per se hindsight reconstruction and is insufficient to establish a prima facie case of obviousness, as stated by the MPEP. Applicants are unable to identify a single instance in which the Examiner has identified a teaching or suggestion in Blumberg to combine the officially noticed facts, much less whether the officially noticed facts are compatible with the complete teachings of Blumberg.

Thus, a prima facie case of obviousness has not been presented by the Examiner with respect to any of the pending claims.

The Examiner also committed clear error by appearing to ignore MPEP 2144.03(A)'s mandate that "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based" (citing *In re Zurko*, 258 F.3d 1379, 1385, (Fed. Cir. 2001)).

Furthermore, despite MPEP 2144.03(A) which also states that the use of Official Notice in final rejections should be "rare" and despite Applicants' proper traversal of the Examiner's prior Official Notice rejections, discussed at length from pages 10 to 15 in the 10/17/05 Response, the Examiner has taken the position in the Final Rejection that Applicants' traversal was improper. See, e.g., Final Action at pages 16-17. Applicants' traversal was clearly proper under MPEP 2144.03. Specifically, MPEP 2144.03(C) states "[t]o adequately traverse such a finding [of Official Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art...A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate."

Applicants have not provided mere allegations that the claims define patentable subject matter. In fact, the 10/17/05 Response contains no less than 5 pages of argument specifically identifying why Official Notice was improper. As one example, Applicants pointed out that the Examiner erroneously alleged that elements not taught by Blumberg "are" well known, without any reference to what was known at the time the invention was made as required by law. Rather than provide a reference to support the Examiner's position, the Examiner provided Applicants with a game of semantics (See Final Action at page 17).

The Examiner is apparently unable to find any suitable reference, and instead maintained the rejection because Applicants did not explicitly request a reference in its place. The MPEP

has no such requirement. The fact that the Examiner was unable to find a single reference to combine with Blumberg in support of the rejection is apparent with reference to the Conclusion of the Final Rejection (Final Rejection at 18). Here, the Examiner cites the only new reference, U.S. Publication 20050243373, also listed on an accompanying Form PTO-892. Thus, the additional reference demonstrates that the Examiner must have been aware of a need to seek additional references because a prima facie case of obviousness had not been established. Yet, the only new reference provided was apparently not even relevant enough to warrant support of the Examiner's own rejections in the explanation of the rejection, but instead was only mentioned in the Conclusion as "pertinent."

CONCLUSION

The Examiner has committed clear error by failing to present a prima facie case of obviousness and by making the rejection final in view of Applicants proper traversal of the Examiner's Official Notice arguments.

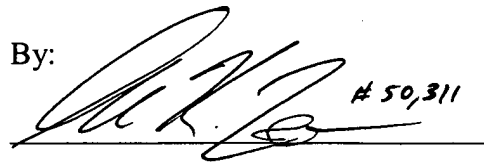
Applicants respectfully request that the Panel withdraw the Final Rejection and allow the Application.

Date: March 22, 2006

Respectfully submitted,

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By:



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Notice of Appeal (in duplicate)
Pre-Appeal Brief Request For Review (5 pages)
PTO/SB/33 (1 page)

Attorney Docket No.: 13DV-13928 (07783-0076)
Application No.: 09/900,684
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